

REMARKS

Reconsideration of this application is respectfully requested. A three-month extension of time to respond to the outstanding Office Action of December 7, 2004 is hereby requested.

Claims 1-141 are pending in the application. Upon entry of this Amendment, claims 1, 7, 25 and 31 will be amended, claims 16 and 54 will be cancelled, and the specification will be amended to reference Provisional Application Serial No. 60/400,063, filed August 2, 2002, to perfect the present application's claim to the benefit of such application.

In accordance with the provisions of MPEP 201.11(D), because a claim to the benefit of the '063 provisional application was made in the Transmittal Sheet filed with this application and in the Inventors Declaration filed with this application within the time period set forth in 37 C.F.R. §1.78(a)(5), and because this claim to the benefit of the '063 provisional application was recognized by the U.S. Patent Office, as shown by its inclusion on the Filing Receipt for this application, it is believed that, a petition, under 37 C.F.R. §1.78(a)(6) and the surcharge required under 37 C.F.R. §1.17(t) are not required to claim the benefit of the '063 provisional application at this time. Nevertheless, the above-noted amendment to the application specification is being filed in accordance with the further provisions of MPEP §201.11(D) that a reference to the provisional application be included in the first sentence of the application specification. Copies of the

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Transmittal Sheet, Inventors Declaration and Filing Receipt for this application are attached to this Amendment at Attachment A for ease of reference by the Office.

The Examiner is thanked for indicating that objected-to claims 3-6, 11-24, 27-30, 33, 34, 37, 38, 41, 43-49, 54-67 and 70-141 would be allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims. Although such claims have not been so amended, in view of the amendments to independent claims 1 and 25 effected by this Amendment and the remarks below regarding the Examiner's rejections of such claims and dependent claims 2, 7, 26 and 31 as being anticipated under 35 U.S.C. §102(b) by Saul (U.S. Patent No. 4,538,607) and/or §102(e) as being anticipated by Ulert *et al.* (U.S. Patent No. 6,576,010 B2), it is believed that such claims are, nevertheless, in condition for allowance.

With regard to the Examiner's rejection of claims 1, 2, 7, 25, 26 and 31 under either §102(b) as being anticipated by Saul and/or §102(e) as being anticipated by Ulert, the Examiner's rejections are respectfully traversed.

For a claim to be anticipated by a reference, every element of the claim must be disclosed in the reference. The cited references do not anticipate the rejected claims because they do not disclose certain elements recited in such claims.

Independent claims 1 and 25 have been amended to make clear that the second valve member is displaceable relative to the first valve member between different positions while the second plane surface touches the first plane surface. In addition, the limitation defined in dependent claims 16 and 54 that "said first and second plane

surfaces of said valve members have a smoothness such that they form a liquid seal as they touch each other" has been added to independent claims 1 and 25, respectively.

Thus, claims 16 and 54 have been cancelled.

In his rejection of claims 1, 2, 7, 25, 26, and 31 under §102(b) as being anticipated by Saul, the Examiner argues that Saul discloses a valve device comprising a first valve member (29) with a first plane surface and a second valve member (membrane 14) with a second plane surface. However, item 29 shown in Figs. 1-4 cited by the Examiner are projections of housing (10) forming air passage means for permanent communication between a tracheostomy cannula and the interior space formed by the housing (10) and cover (13). *See, Saul, col. 3, lns. 15-20*). Because Saul's element (29) is a projection with a rounded tip, see Figs. 1-4 of Saul cited by the Examiner, projection (29) does not have a plane surface that touches a plane surface of membrane (14). Rather, projection 29 clearly has a curved surface that touches membrane (14). Furthermore, Saul's membrane (14) is not displaceable relative to the projection (29) between different positions, while the plane surface of membrane (14) touches the surface of projection (29). Figures 2 and 4 of Saul clearly show how membrane (14) is spaced apart from the projections (29) when it is displaced to another position. As such, amended independent claims 1 and 25, which now recite that the second plane surface touches the first plane surface when being displaced relative to the first plane surface, are not anticipated by Saul's valve device.

With regard to the Examiner's rejection of claims 7 and 31 as being anticipated by Saul, such claims have been amended to make clear that the second plane surface of the second valve member slides on the first plane surface of the first valve member when the second valve member is displaced between the different positions. Although the Examiner argues in his rejection of claims 7 and 31 that the second member (14) is capable of sliding on the first plane surface of the first valve member (29), the Examiner fails to explain where in Saul there is a teaching that supports the Examiner's contention. But even assuming, *arguendo*, that the second member is capable of sliding on the first plane surface of the first valve member, as argued by the Examiner, such sliding does not occur when the second valve member is displaced to a different position, as shown in Figs. 2 and 4 of Saul. As such, claims 7 and 31 are not anticipated by Saul's valve device.

In rejecting claims 1, 2, 25 and 26 under §102(e) as being anticipated by Ulert, the Examiner argues that Ulert discloses a valve device comprising a first valve member (12) with a first plane surface and a second valve member (11) with a second plane surface facing and touching the first plane surface, referencing Fig. 1 of Ulert. The Examiner further argues that the second member is displaceable relative to the first member between different positions, referencing Figs. 1-5, and that the valve members include different liquid channels, (3) and (4) wherein the second valve member is adapted to connect at least two different channels to each other and at least one of the positions.

The items (11) and (12) shown in Ulert are a first piston (11) and a second piston (12) of an artificial heart. *See*, Ulert, col. 2, lns. 49-51. First piston (11) and second piston (12) are sized to fit within an aperture (10). *See*, Ulert, col. 2, lns. 54-60. Figs. 1-5 show the movement of piston (11) within aperture (10) as electromagnets 16-27 are operated. In Fig. 1, Ulert's artificial heart is in its starting position with aperture (10) filled with blood. Piston (11) is positioned so as to close off communication of intake opening (3) and aperture (10). As various ones of electromagnets 16-27 are turned on and off, piston (11) is moved along aperture (10) so as to push the volume of blood in aperture (10) forward and out of outflow opening (4). As piston (11) moves along aperture (10), it also forms a vacuum behind it, causing blood to flow through intake opening (3) into aperture (10) behind first piston (11). *See*, Ulert, col., 3, lns. 54-63. Fig. 5 illustrates a final position of a cycle of Ulert's artificial heart. At that point, electromagnetic assembly (16) is turned off and electromagnetic assembly (17) is turned on to move second piston (12) into a position to close the communication between aperture (10) and intake opening (3). A second cycle is then begun with piston (12) moving radially along aperture (10) and pushing the volume of blood out outflow opening (4). *See* Ulert, col. 4, lns. 1-13. Thus, piston (11) is not displaceable relative to piston (12) between different positions while the plane surface of piston (11) touches the surface of piston (12). Therefore, amended claims 1 and 25 are also not anticipated by Ulert's valve device.

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The Examiner further argues that Ulert's "valve members" (11) and (12) include different liquid channels. This is not correct because, as seen in Figs. 1-5, pistons (11) and (12) clearly do not include any liquid channels since they serve to push blood out and draw blood into aperture (10) through openings 3 and 4.

Because independent claims 1 and 25 are not anticipated by Saul or Ulert, dependent claims 2, 7, 26 and 31, which depend from one or the other of claims 1 and 25, are also not anticipated by such references. As such, claims 1, 2, 7, 25, 26 and 31 should now be in condition for allowance. In addition, because withdrawn claims 8-10, 32, 35, 36, 39, 40, 42, 50-53 and 68-69, which are drawn to a nonelected species, depend, either directly or indirectly, from claims 1 or 25, Applicant respectfully requests that the Examiner consider such withdrawn claims for allowance in this application, as well.

In view of the foregoing, it is believed that all of the claims in the application, *i.e.*, claims 1-141 are now in condition for allowance, which action is earnestly solicited. If

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any issues remain in this application, the Examiner is urged to contact the undersigned at the telephone number listed below.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By: Robert A. Molan
Robert A. Molan
Reg. No. 29,834

RAM:dt
901 North Glebe Road, 11th Floor
Arlington, VA 22203
Telephone: (703) 816-4000
Facsimile: (703) 816-4100